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REMARKS

Claims 1-26 are all the claims pending in the application.

Applicants note with appreciation that the Examiner has withdrawn the §102 rejection, the §103 rejection based solely on Balaji, and the §103 rejection based solely on Katsura.

With respect to the §112 rejection presented at paragraph Nos. 1-2 of the present Action, Applicants have made non-narrowing amendments to claim 24. Accordingly, Applicants request the withdrawal of the §112 rejection.

The remaining art rejections are as follows:

claims 1-8 and 10-26 are rejected under 35 U.S.C.§ 103(a) as allegedly being unpatentable over U.S. Patent 6,150,013 to Balaji, *et al.* ("Balaji") in view of U.S. Patent 5,897,722 to Bright ("Bright"); and

claim 9 is rejected under 35 U.S.C.§ 103(a) as allegedly being unpatentable over Balaji in view of Bright and further in view of U.S. Patent 5,223,315 to Katsura, *et al.* ("Katsura").

Applicants respectfully traverse both rejections.

The Examiner has taken the position that it would have been obvious for a person of ordinary skill in the art "to have provided a cold glue adhesive on the first side of the first skin layer in Balaji et al. as suggested by Bright in order to adhere a label to an article" (Applicants refer to the first full paragraph at page 3 of the Action). The Examiner notes that "Bright teaches in the analogous art a cold glue adhesive (see col. 4, lines 39-41) for the purpose of adhering a label to an article."

Applicants respectfully disagree.

If the proposed modification or combination of the prior art disclosure(s) would change the principle of operation of the prior art invention being modified, then the teachings of the reference(s) are not sufficient to render the claims *prima facie* obvious [*see*, In re Ratti, 123

USPQ 349 (CCPA 1959)]. In other words, a prior art reference may not be modified so as to destroy its teachings.

In the present case, it is simply impossible to employ a cold-glue adhesive in an in-mold label application, such as that disclosed in Balaji. Therefore, Balaji cannot be modified in view of Bright.

Specifically, during in-mold labeling, polymeric label stock is combined with heat-activatable adhesive. The polymeric labels are then sequentially deployed on the molding surface of a blow mold to be bonded onto successive hot plastic substrates or containers. The blow-molded parsons are expanded against the molding surface and the in-mold label, which activates and bonds the heat-activatable adhesive to the blown plastic substrate or container (Applicants refer to column 1, lines 48-59 of Balaji). In other words, a label is applied to the plastic container or substrate as the container or substrate is molded, whereby the heat of the molding process activates the adhesive and the label becomes part of the container wall.

In the context of applying a label to a plastic substrate or container, there is in-mold labeling, as described above, and so-called post-mold labeling. During post-mold labeling, a label is applied to a plastic substrate or container using, e.g., cold-glue adhesive after the plastic substrate or container has been molded.

Accordingly, a person of ordinary skill in the art would never be motivated to modify a polymeric label for in-mold labeling by providing a cold-glue adhesive on a side thereof. A label for in-mold labeling needs an adhesive (or heat-seal layer, as disclosed at column 2, lines 34-35 of Balaji) that is heat-activated.

Interestingly, in-mold labeling as disclosed in Balaji is completely irrelevant to a preferred application of the present invention, which is to apply the claimed labels to a glass container, such as a beer bottle. The present examples illustrate the application of labels onto a glass container. Glass containers are not and cannot be labeled by in-mold labeling.

The disclosure at column 4, lines 39-42 of Bright merely discloses that Bright's glue applicator can be used to apply several different kinds of adhesives, including hot melt glue and cold glue, to containers or substrates in applications where the container or substrate to be

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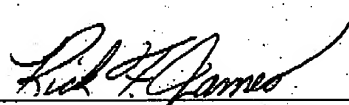Attorney Docket: 10247
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labeled has already been formed. Indeed, the entirety of Bright's disclosure relates to labeling in applications where the container or substrate to be labeled has already been formed, *e.g.*, post-mold labeling (Applicants refer, for example, to the disclosure at column 4, lines 18-22). Bright's disclosure does not at all relate to in-mold labeling, and nowhere does Bright disclose or teach the provision of a cold-glue adhesive on a polymeric label for in-mold labeling.

For each of the foregoing reasons, the combined disclosures of Balaji and Bright cannot be combined and do not lead a person of ordinary skill in the art to the present invention.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: March 6, 2003

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

   Claim 24 is amended as follows:

   24. (AMENDED)   A thermoplastic label ~~adapted to be applied~~ for applying to a container, comprising:

   a.   a first skin layer comprising polypropylene and a first cavitating agent, wherein the first skin layer has a first side and a second side, and the first skin layer is cavitated; <u>and</u>

   b.   a cold glue ~~applied to~~ <u>on</u> the first side of the first skin layer ~~wherein the label is adapted to be applied to the container.~~